

REMARKS

Claims 2-4 and 8-11 have been examined. Claims 2, 3, and 10 have been amended, and claims 5-9 and 11-14 have been canceled without prejudice or disclaimer. Applicants reserve the right to pursue the canceled subject matter in future applications. With the entry of this amendment, claims 2-4 and 10 are pending in this application.

Claim 2 has been amended to recite “position 1179 of the nucleotide sequence of SEQ ID NO: 22” as suggested by the Examiner. Support for the amendment can be found throughout the specification, including, for example, at pages 11-12. Claim 2 has been further amended to recite “judging the beagle dog with a C/C genotype or a C/T genotype to be an extensive metabolizer and the beagle dog with a T/T genotype to be a poor metabolizer.” Support for this amendment can be found in the specification, for example, on page 12, at [0018].

Claim 3 has been amended to recite “selecting a beagle dog with a C/C genotype or a C/T genotype as the extensive metabolizer or a beagle dog with a T/T genotype as the poor metabolizer.” Support for the amendment can also be found in the specification, for example, at least on page 12, at [0018].

The amendment to claim 10 changes the dependency of that claim from a canceled claim to a pending claim. The amendment to paragraph [0018] of the specification is of a minor clerical nature and cures a typographic error, support for which is found earlier in the same paragraph. The amendments add no new matter. Accordingly, Applicants respectfully request reconsideration of the application.

Information Disclosure Statement

Applicants include an information disclosure statement presenting the articles referenced in the specification at pages 6-7. Applicants respectfully ask that this IDS be added to and maintained in the file wrapper for the present application.

Claim Rejections

I. Rejection of claims 2-4 and 8-11 Under 35 U.S.C. § 112, ¶ 1 - Written Description

Claims 2-4 and 8-11 were rejected under 35 U.S.C. 112, first paragraph, for allegedly containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicants respectfully traverse this rejection.

To facilitate the prosecution and without acquiescing to the rejection, Applicants have amended claim 2 to remove the reference to “position 1117 of a beagle CYP1A2 gene” and instead recite “position 1179 of the nucleotide sequence SEQ ID NO: 22.” Upon entry of this amendment, Applicants assert that the claimed invention is adequately described by the present application. The specification does provide sufficient written description for determining whether a beagle dog is an extensive metabolizer or a poor metabolizer by analyzing a base corresponding to a base at position 1179 of SEQ ID NO: 22, and determining the CYP1A2 genotype at the base corresponding to a base at position 1179 of SEQ ID NO: 22, because the sequence and base position relating to the genotype determination are expressly defined.

Furthermore, claims 3, 4, and 10 incorporate this language and thus also satisfy the written description requirement of § 112, first paragraph. Claims 8, 9, and 11 have been

canceled, and thus the rejection of these claims is moot. Accordingly, Applicants respectfully request withdrawal of the rejection.

II. Rejection of claims 2-4 and 8-11 Under 35 U.S.C. § 112, ¶ 1 - Enablement

Claims 2-4 and 8-11 were rejected under 35 U.S.C. § 112, first paragraph, because “the specification, while being enabling for a method of sequencing the known Dah2 gene from beagles, does not reasonably provide enablement for a method for detecting a canine CYP1A2 genetic polymorphism in any canine and associating the polymorphism with ‘extensive’ and ‘poor’ metabolizers.” (Office Action at p. 8). Applicants respectfully traverse this rejection.

To facilitate the prosecution and without acquiescing to the rejection, Applicants have amended claim 2 to recite “judging the beagle dog with a C/C genotype or a C/T genotype to be an extensive metabolizer and the beagle dog with a T/T genotype to be a poor metabolizer.” Upon entry of this amendment, Applicants assert that the specification fully enables the determination of whether a beagle dog is an extensive metabolizer or a poor metabolizer by analyzing a base corresponding to a base at position 1179 of SEQ ID NO: 22 and determining its genotype because the polymorphism is at a specifically identified position within the claimed sequence and the assigned correlation of genotype to phenotype is recited in the claim.

Furthermore, claims 3, 4, and 10 incorporate this language and thus also satisfy the enablement requirement of § 112, first paragraph. Claims 8, 9, and 11 have been canceled, and thus the rejection of these claims is moot. Accordingly, Applicants respectfully request withdrawal of the rejection.

III. Rejection of Claims 2-4 and 8-11 under 35 U.S.C. § 112, ¶ 2

Claims 2-4 and 8-11 remain rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for the recitation of “a base corresponding to a base at position 1117 of a beagle

CYP1A2 gene” because it is allegedly unclear where position 1117 lies in relation to the gene.

Applicants respectfully traverse this rejection.

To facilitate the prosecution and without acquiescing to the rejection, Applicants have amended claim 2 to recite “position 1179 of the nucleotide sequence SEQ ID NO: 22,” and acknowledge the Examiner’s suggestion in this regard. Upon entry of this amendment, Applicants assert that the claimed particularly points out and distinctly claims the subject matter because the sequence and base position relating to the genotype determination are expressly defined.

Furthermore, claims 3, 4, and 10 incorporate this language and thus also satisfy the definiteness requirement of § 112, second paragraph. Claims 8, 9, and 11 have been canceled, and thus the rejection of these claims is moot. Accordingly, Applicants respectfully request withdrawal of the rejection.

IV. Rejection of Claims 2-4 under 35 U.S.C. § 102

Claims 2-4 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Uchida et al. (*Molecular Pharmacology* 38:644-651, 1990). The Office made the rejection because it was “unclear what the claimed method actually required.” (Office Action at p. 14) The Office further indicated that “[i]n the event that the claims only require the active process steps claimed, the following rejection is appropriate.” *Id.* Applicants respectfully traverse this rejection.

To facilitate the prosecution and without acquiescing to the rejection, Applicants have amended claim 2 to recite “judging the beagle dog with a C/C genotype or a C/T genotype to be an extensive metabolizer and the beagle dog with a T/T genotype to be a poor metabolizer.”

Upon entry of this amendment, Applicants assert that the claims do differentiate the metabolizer status by genotype, and that this active process step is not taught by Uchida.

Furthermore, claims 3 and 4 incorporate this language and thus are also novel over Uchida. Accordingly, Applicants respectfully request withdrawal of the rejection.

In view of the foregoing amendments and remarks, Applicants respectfully request entry by the Examiner of this Amendment under 37 C.F.R. § 1.116, reconsideration of this application, and the timely allowance of claims 2-4 and 10. Applicants submit that the proposed amendments of claims 2, 3, and 10 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships were either claimed earlier or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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